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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,973	02/25/2004	Toshiaki Igarashi	03500.100142.	8991

5514 7590 06/18/2007
FITZPATRICK CELLA HARPER & SCINTO
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NEW YORK, NY 10112

EXAMINER

NGUYEN, CINDY

ART UNIT	PAPER NUMBER
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2161

MAIL DATE	DELIVERY MODE
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06/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/784,973

Applicant(s)

IGARASHI, TOSHIAKI

Examiner

Cindy Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/10/07 has been entered.

Response to Arguments

Applicant argued on claims amended was not persuasive. Please see the rejection below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 10 recite the limitation "list". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-, 2, 4-9, 11-17 are rejected under 35 U.S.C. 102(e) as being anticipated by James Michael Metz, US Patent Publication No. 2004/0019671 and hereinafter referred to as Metz.

As to claims 1,2,6,9, 12 and 13, Metz teaches a network device (Fig. 4A; [0004]) managing apparatus comprising:

receiving unit adapted to receive a search request of network devices (Fig. 4A; [0004, 0024, 0025] and identification information from a data processing apparatus(i.e., printing device information such as: a model type, hardware address, port, IP address, IP host, status of the printer device, 0021);

searching unit adapted to search network devices in response to the search request received by said receiving unit (i.e., filter queries the main device list for information that satisfies one or more criteria for each secondary list. (0024));

obtaining unit adapted to obtain a past device list (the main device list) associated with the identification information received by said receiving unit (i.e., filter queries the main device list for information that satisfies one or more criteria for each secondary list. (0024, 0025)), the past device list indicating a search result at the time when searched before the search by said searching unit (i.e., network management tool 104 can send a query to all printing devices on network and listen for responses and/or can monitor the network for signals indicating that printing devices are present on the network... discover new printer and updating the main device list (0022));

Comparing unit adapted to compare the search result by said searching unit with the past device list obtained by said obtaining unit (Metz teaches a network management device that periodically performs printer discovery and updates the main device list. User can create secondary lists by using some criterion to filters ([0024]). The filter queries (i.e., requests) the main device list (requests can be initiated by the user or periodically) ([0031]; [0032]). The user can specify in the criterion that "give me a list of all LJ9000 printers" in the query request of the filter. The system will return a list of LJ9000 from the network and show on the screen (the list must be stored somewhere e.g., memory to be shown on the screen). If at a later time the user sends the same query request and a new printer of type LJ9000(i) has been added to the network in between the request times, the returned list will have a new printer, and the screen page would bolder (i.e., emphasize) the new printer (i.e., LJ900(i)) ([0040]) on the list. Therefor it is very clear that a comparison has occurred between the old list and the

new list. Another user with the same query at a different time would see different printers emphasized.;

Forming unit adapted to specify from among the network devices searched by said searching unit the network device not presented in the past device list, and forming a device list in which the specified network device has been emphasized (0025, 0040) ; and

Transmitting unit adapted to transmit the device list formed by said forming unit to said data processing apparatus (i.e., displayed in the users' or administrators' computer screen) (Fig. 6).

As to claims 4,7 and 11, Metz teaches wherein the device list formed by said data forming means includes an emphasis mark to emphasize ([0040]).

As to claims 5 and 8, Metz teaches wherein the device list formed by said data forming means includes instruction data for allowing a device icon of the data processing apparatus to be displayed in an updated state (Fig. 5).

As to claims 14 and 16, Metz teaches wherein said obtaining unit obtains the past device list held by said holding unit (i.e., the network management tool 104 tool creates a main device list 302, by discovering all the printing devices on the network 100 and then recording information associated with the printing devices 102 in the main device list 302, 0021).

As to claims 15 and 17, Metz teaches wherein the identification information is a network address of the data processing apparatus (i.e., printing device information such as IP address, IP host, hardware address, 0021).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over James Michael Metz, US Patent Publication No. 2004/0019671 and hereinafter referred to as Metz in view of Boldt et al. (US 6349304) (hereafter Boldt).

As to claims 3 and 10, Metz didn't teaches wherein said list indicates at least one of information regarding whether printing is possible or not and an error state. On the other hand, Boldt discloses: wherein said list indicates at least one of information regarding whether printing is possible or not and an error state (i.e., indicated whether the printer 8a, b,c,d should continue printing after a printing error, col. 4, lines 42-48). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include said list indicates at least one of information regarding whether printing is possible or not and an error state in the system of Metz as taught by Boldt. The motivation being to determined set of features may be transmitted to

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different target devices when the target devices have different capabilities with respect to the determined set of features, the target devices are configured with the values transmitted over the network, col. 1, lines 57-62, Boldt.

Contact information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cindy Nguyen whose telephone number is 571-272-4025. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Cindy Nguyen

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